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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,397	05/10/2005	Patrice Martinez	41052/315490	2853
23370	7590	12/31/2007		
JOHN S. PRATT, ESQ KILPATRICK STOCKTON, LLP 1100 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER GEHMAN, BRYON P	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 12/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/534,397

Applicant(s)

MARTINEZ ET AL.

Examiner

Bryon P. Gehman

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37.CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☒ Claim(s) 11,14 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/20/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in **37 CFR 1.56**.

Only 37 CFR 1.56(a) is specified, when the entire section needs to be identified.

2. The drawings are objected to because they include the foreign filing numerals thereon. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

**The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.**

4. The abstract of the disclosure is objected to because the opening phrase "The invention concerns" may be implied and is unnecessary. In line 2 of the Abstract, legal phraseology is employed. Correction is required. See MPEP § 608.01(b).

5. Claim 13 is objected to because of the following informalities: In claim 13, line 3, "than width of" is ungrammatical. Appropriate correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 9, line 4, "two doors having each closure means" lacks antecedent basis, which may be corrected by transposing "having each" to --each having--. Also in line 4, "said goggles" lacks antecedent basis, as no goggles per se are defined by the preamble nor defined as part of the claimed invention. In each instance of "said goggles", the phrase should be changed to --the goggles--, as only positively defined elements of the invention are --said...--. See also claim 9, lines 7, 8-9, 12, 14 and 14-15, claim 10, line 4 (twice), claim 11, line 4 (twice), claim 12, line 2, claim 13, line 3, claim 14, lines 2-3, 3, 5-6 and 7 claim 15, lines 4, 6 and 7.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte*

*Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instances, claim 9 recites the broad recitation "at least two end positions" in line 6 and the claim also recites "a closed position...and an open position...to be removed from the case" in lines 6-9 which is the narrower statement of the range/limitation. In claim 15, the claim recites the broad recitation "two indentations" in line 2, and the claim also recites "namely a top indentation..."bottom indentation of the other door" in lines 2-5 which is the narrower statement of the range/limitation.

In claim 9, lines 10-11, "corresponding to a bilateral plane of symmetry of said goggles" is indeterminate and indefinite, as the invention is not defined to include the goggles, rendering the plane of bilateral symmetry of goggles being absent from the claimed invention. In line 12, "said center plan" lacks antecedent basis, as "plan" should probably be --plane--. In line 12 the phrase "approaches the center plan said closure edge" is indefinite as to its meaning unless it is missing a comma. Also, "said closure edge" is indefinite, as line 11 defines two closure edges.

In claim 12, the recitation of the "goggles" as protective goggles" in this instance is indefinite as to its significance, as in all other instances the goggles are merely described as goggles.

In claim 13, absent the goggles, the side wall to goggles relationship is indeterminate.

In claim 14, line 6, "said nose" lacks antecedent basis, as no person's nose is part of the case nor does one particular nose distinguish the case.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers (6,039,174). Claims 9-10 and 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Barhydt et al. (5,493,349). Claims 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by FR 1,060,691. Each discloses a storage case capable of receiving eyewear, the case comprising a case bottom (1 less 2 and 3; 14; 2; respectively), and two doors (2 and 3; 20a and 20b; 3 and 3) each having a closure means (7-10; 50 and 52 and the shown hinges; 8 and 9 and 4-5) designed to secure contents within the case, the doors being articulated on the case bottom between a closed position (Figure 1; Figure 4; Figure 1) and an open position (Figure 2; Figure 1; Figure 2), wherein the two doors are symmetrical to a center plane (bisecting 1; where 20a and 20b abut; where the free edges of 3 and 3 meet) of the case, each door having a closure edge (curved outer edges of 2 and 3; 50 and 52; the free edges of 3 and 3) which in the closed position approaches the center plane, each closure edge having at least one indentation (defining the inside area of 2 and 3; inside 48 of each; defining the inside of 3) that allows gripping of contents of the case. .

As to claim 10, the case of Barhydt et al. may hold its eyewear contents in the case even if the contents are not held by the case bottom (14).

As to claim 12, each discloses the case bottom having a shape designed to hold its contents in the case when the case is open.

As to claim 13, the case bottom of Barhydt et al. has side walls (between its lowermost plane and 28, see Figure 2) whose distance from each other is smaller than the width of the intended contents.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Rogers, Barhydt et al. and FR 1060691 in view of Jacobson (2,747,760). The base references do not disclose providing the doors as transparent. Jacobson discloses providing an eyewear case from transparent material to provide exterior visibility of the interior of the case. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the storage case of any one of Rogers, Barhydt et al. and FR 1060691 from transparent material as claimed, as such a modification would predictably provide exterior visibility of the interior of the case. "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int 'l v. Teleflex Inc.*, 127 S.Ct. 1731, 82 USPQ2d at 1396. One of ordinary skill in the art would recognize that using transparent



material for an eyewear case, as disclosed by Jacobson to be known in the field of eyewear case, would enable viewing of the contents of the case from outside the case.

12. Claims 11, 14 and 15 would each be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Chiang references show cases for eyewear, Chiang ('959) showing a hinged structure, and Chiang ('217) showing goggles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Tuesday through Thursday from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Bryon P. Gehman  
Primary Examiner  
Art Unit 3728

BPG